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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,944	03/31/2004	Frank Westendorf	07781.0080-00	4926

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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EXAMINER

LEWIS, CHERYL RENE A

ART UNIT	PAPER NUMBER
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2167

MAIL DATE	DELIVERY MODE
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01/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/812,944

Applicant(s)

WESTENDORF ET AL.

Examiner

Cheryl Lewis

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36, 37, 41-44, 48-51, 55, and 56 is/are rejected.
- 7) ☒ Claim(s) 38-40, 45-47 and 52-54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the applicants' communication received on October 1, 2007.
2. Claims 36-56 are presented for examination.
3. The applicants have cancelled claims 1-35 and have introduced new claims 36-56.
4. Applicants' arguments with respect to claims 36-56 have been considered but are deemed to be moot in view of the new grounds of rejection.

Allowable Subject Matter

5. Claims 38-40, 45-47, and 52-54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 36, 37, 441-44, 48-51, 55, and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Schuler et al. (Patent No. 5,855,005 filed June 24, 1996, hereinafter Schuler).

8. Regarding Claims 36, 43, and 50, Schuler teaches a system for electronically auditing exposures used for determining insurance premiums.

The method and associated system for electronically auditing exposures used for determining insurance premiums as taught or suggested by Schuler includes:

identifying at least one initial data object to be processed has been selected (col. 6, lines 1-4, element 730, 'Appointment Letters'), at least one process chain containing a selected data object to be processed (col. 6, lines 25-34, 'The Menu 800 includes boxes 810, 820, 830, and 840 which correspond to different pre-prepared form letters to be used by an auditor in scheduling audit appointments.');

determining all of the data objects (col. 6, lines 1-24, figures 1 and 7, '...by clicking on box 730, the auditor may direct system 100 to proceed to step 122 wherein one or more appointment letters may be issued to insureds being audited'; '...elements 122, 124, 126, 132, 136, or 138, system 100 proceeds back to step 120 where the Policy View/Audit View Menu 700 is displayed for the auditor.') which are linked with a selected data object (col. 6, lines 1-24, 'Appointment Letter', i.e., '...by clicking on box 730') in a causal relation (col. 6, lines 1-24, '...one or more appointment letters may be issued to insureds being audited');

and processing determined data objects (col. 6, lines 25-34, 'The Menu 800 includes boxes 810, 820, 830, and 840 which correspond to different pre-prepared form letters to be

used by an auditor in scheduling audit appointments.', col. 6, lines 34-44, 'Upon clicking one of the boxes 810, 820, 830, or 840, a form of an appointment letter (such as, for example, letter 900 shown in FIG. 9) is automatically generated by system 100. In generated this form letter, system 100 pre-fills the insured's name and address, policy type, policy number and policy period into the letter based on information previously entered and stored in database 400. In order to complete the appointment letter 900, an auditor then enters a contact name 910, an audit date 920 and designates the records 930 that will be required for the audit.') and initial data object (col. 6, lines 1-24, 'Appointment Letter', i.e., '...by clicking on box 730') to assign an action (col. 6, lines 1-47, i.e., 'an Appointment Letter Menu') to determined data objects and to initial data object.

9. Regarding Claims 37, 41, 42, 44, 48, 49, 51, 55, and 56, the limitations of these claims have been noted in the rejections of claims 36, 43, and 50 presented above. They are therefore rejected as set forth above.

NAME OF CONTACT

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham

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can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cheryl Lewis/
Patent Examiner, A.U. 2167
January 7, 2008